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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,309	02/22/2002	Sung Woo Yang	742-01110503	8183

25864 7590 08/24/2004

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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/080,309

**Applicant(s)**

YANG, SUNG WOO

**Examiner**

James H Zurita

**Art Unit**

3625

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, databases, title, subject, author, etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

***Double Patenting***

Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/082188, filed 26 February 2002, entitled Method of Narrow Search for Books on the Internet.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Narrow Searching with knowledge generally available to disclose the steps of claim 1, including (a) storing book identifying information for every book carried by the vendor in a main database; (b) storing book identifying information for every book previously ordered by a customer in a customer database; (c) displaying a screen to assist in entering book identifying information; (d) accessing the main database to match the book identifying information entered by the customer with the book identifying information stored in the main database and generating a search result comprising the matching book identifying information; (e) displaying the search result; (f) accessing the customer database to match the book identifying information entered by the customer with the book identifying information stored in the customer database and generating a previous orders result comprising the matching book identifying information; (g) displaying the previous orders result; (h) displaying means for entering book orders; and (i) generating book orders.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the system of Narrow Searching with knowledge generally

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available to disclose the steps of claim 1 for the obvious reason that searching and ordering books though the Internet may yield too many results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 6 and 7 require executing numerous functions ***simultaneously***, that is, existing or occurring at the same time:<sup>1</sup>

<b>Claim 6</b>	<b>Claim 7</b>
A method as in claim 1 wherein the step of <b>(a) accessing the main database...</b> <b>(b) match[ing] ... and</b> <b>(c) generating a [first] result...</b>	A method as in claim 1 wherein the step of <b>(a) displaying</b> said [first] result
is performed simultaneously with the step of <b>(d) accessing the customer database...</b> <b>(e) match[ing] ... and</b> <b>(f) generating a [second] result...</b>	is performed simultaneously with the step of <b>(b) displaying</b> said [second] result.

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<sup>1</sup> Definition of *simultaneous*, MERRIAM WEBSTER'S Collegiate Dictionary

It is not clear how applicant envisions these functions as taking place at the same time, particularly since the functions are sequential by definition and depend on this sequence to produce a result. The functions also require different inputs and produce different outputs. Additionally please note that applicant requires that functions carried out under the control of a customer system need to be sent to the server via the Internet and that functions carried out under the control of a vendor server system need to be sent to the client over the Internet.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1(a) and 1(b) are missing a verb:

1. A method of searching and ordering books via the Internet comprising the steps of:
  - (a) under control of a vendor server system, ??? book identifying information for every book carried by the vendor in a main database;
  - (b) under control of the vendor server system ??? book identifying information for every book previously ordered by a customer in a customer database;

From context, the Examiner believes applicant intended to have claim1(a) and 1(b) refer to **...storing...**

1. A method of searching and ordering books via the Internet comprising the steps of:
  - (a) under control of a vendor server system, **storing** book identifying information for every book carried by the vendor in a main database;
  - (b) under control of the vendor server system **storing** book identifying information for every book previously ordered by a customer in a customer database;

Claim 1 uses the term "means for." This appears to be an attempt to invoke 35

U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. However, since the disclosures provide no structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

(c) under control of the customer system, displaying input **means for** entering book identifying information;

...

(h) under control of the customer system, displaying **means for** entering book orders;

(i) under control of the vendor server system, in response to the book orders entered by the customer in said input **means for** entering book orders, generating book orders.

Related Figs. 1-4 show output displayed on an output device. Output is the result of processing, whether sent to the screen or printer, stored on disk as a file, or sent to another computer in a network.<sup>2</sup> Input is information entered into a computer or program for processing, as from a keyboard or from a file stored on a disk drive.<sup>3</sup> An input device is a peripheral device whose purpose is to allow the user to provide input to a computer system.<sup>4</sup> Examples include keyboard, mice, joystick and styluses.

Claim 1 is indefinite in that it is not clear how applicant can output a display on a computer screen [physical device] yet have the structure be used as a means for entering input. For purposes of this examination, the claim will be interpreted to *not* invoke the sixth paragraph.

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<sup>2</sup> Definition of *output*, MICROSOFT Computer Dictionary.

<sup>3</sup> Definition of *input*, MICROSOFT Computer Dictionary

<sup>4</sup> Definition of *input device*, MICROSOFT Computer Dictionary.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamonoue (US 6,745,180) in view of Garrett (US 6,473,738).

***As per claim 1***, Yamanoue discloses methods for searching and ordering books via the Internet, including the steps of:

(a) at a server, storing book identifying information for every book carried by the vendor in a main database; see, for example, at least Figs. 1 and 13, items 21, 39 and related text.

(b) at a server, storing book identifying information for every book previously ordered by a customer in a customer database; see, for example, at least references to user databases, Fig. 1, 13, item32 and related text.

(c) at a client, displaying a screen to assist in entering book identifying information,. See, for example, at least Fig. 16 and related text.

(d) at a server, accessing the main database to match the book identifying information entered by the customer with the book identifying information stored in the main database and generating a search result comprising the matching book identifying information. See, for example, Col. 8, lines 35-48.



(e) at a client, displaying the search result. See, for example, at least Fig. 16 and related text.

(f) at a server, in response to book identifying information entered by the customer in the input means, accessing the customer database to match the book identifying information entered by the customer with the book identifying information stored in the customer database and generating a previous orders result comprising the matching book identifying information. See, for example, at least Fig. 16 and related text, showing books already ordered by a customer.

(g) at a client, displaying the previous orders result; see, for example, at least Fig. 16 and related text.

Yamanoue **does not** provide specific details concerning (h) entering orders for books and (i) generating book orders. Garrett discloses order fulfillment. In Garrett, see, for example, at least Figs. 18-22 and checkout process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamanoue and Garrett to disclose (h) entering orders for books and (i) generating book orders.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamanoue and Garrett to disclose (h) entering orders for books and (i) generating book orders for the obvious reason that one may wish to manage a multiple-person shopping experience by being able to compare and keep separate selections for different parties.

**As per claim 2**, Yamanoue **does not** use the terms ISBN and international standard book number. Garrett discloses that book identifying information may comprise an international standard book number. See, for example, at least Fig. 3 and related text, Col. 9, lines 4-17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamanoue and Garrett to disclose the use of ISBN. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamanoue and Garrett to disclose the use of ISBN for the obvious reason that ISBN's provide a quick, efficient way of entering and obtaining information concerning a book, thereby decreasing search time and making a shopping experience quicker.

**As per claim 3**, Yamanoue discloses that book identifying information may comprise a title. See, for example, at least Col. 1, lines 1-33.

**As per claim 4**, Yamanoue discloses that book identifying information may comprise an author. See, for example, at least Col. 1, lines 1-33.

**As per claim 5**, Yamanoue discloses that book identifying information may comprise a subject. See, for example, at least references to keyword searches, Fig. 3 and related text.

**As per claim 6** Yamanoue discloses simultaneously displaying several types of information, as in Fig. 16 and related text. See also claim 1, above:

(a) at a server, storing book identifying information for every book carried by the vendor in a main database; see, for example, at least Figs. 1 and 13, items 21, 39 and related text.

(b) at a server, storing book identifying information for every book previously ordered by a customer in a customer database; see, for example, at least references to user databases, Fig. 1, 13, item32 and related text.

(c) at a client, displaying a screen to assist in entering book identifying information,.

See, for example, at least Fig. 16 and related text.

(d) at a server, accessing the main database to match the book identifying information entered by the customer with the book identifying information stored in the main database and generating a search result comprising the matching book identifying information. See, for example, Col. 8, lines 35-48.

(e) at a client, displaying the search result. See, for example, at least Fig. 16 and related text.

(f) at a server, in response to book identifying information entered by the customer in the input means, accessing the customer database to match the book identifying information entered by the customer with the book identifying information stored in the customer database and generating a previous orders result comprising the matching book identifying information. See, for example, at least Fig. 16 and related text, showing books already ordered by a customer.

(g) at a client, displaying the previous orders result; see, for example, at least Fig. 16 and related text.


**As per claim 7**, Yamanoue discloses simultaneous display of search result(s) and previous orders result(s). See, for example, at least Fig. 16 and related text.

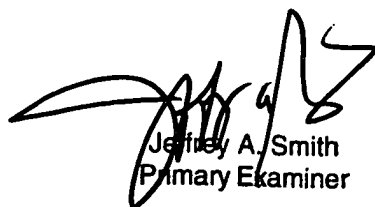
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
17 August 2004

  
Jeffrey A. Smith  
Primary Examiner